Patent
Attorney's Docket No. 1011350-000265

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	
Tomohiko Teranishi et al.	Group Art Unit: 2626
Application No.: 09/729,351	Examiner: Michael L. Burleson
Filed: December 5, 2000	Confirmation No.: 6715
For: APPARATUS, METHOD AND COMPUTER PROGRAM PRODUCT FOR PROCESSING DOCUMENT IMAGES OF VARIOUS SIZES AND ORIENTATIONS	

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection of claims 6-11 set forth in the Office Action dated July 28, 2005. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Background

The claimed subject matter is directed to the processing of images for printing, wherein an individual print job may comprise images of multiple documents having different respective sizes and/or orientations. Examples of individual print jobs that comprise documents of different sizes and/or orientations are depicted in Figures 8, 11 and 23 of the application. In accordance with various embodiments of the invention, the sizes and/or orientations of the various document images in a print job are taken into account, to determine an appropriate layout for the images on sheets of paper to be printed.

Claim 6

Claim 6 is directed to an embodiment of the invention in which the output paper, on which an image is formed, is automatically selected on the basis of the maximum size of the multiple document images that are to be printed. The claim recites an image forming apparatus having a receiving unit that receives a print job

comprising image data based on multiple document images of various sizes, and a detecting unit for detecting the maximum size of the document images. The claim further recites "a selecting unit for selecting paper with a size equal to or larger than the detected maximum size." Hence, the selection of the paper on which to print the multiple document images is carried out on the basis of the detected maximum size of those document images.

Claim 6 was rejected under 35 U.S.C. §103, on the basis of the Moro patent in view of the Miyake patent. As set forth in the Advisory Action dated January 9, 2006, the rejection relies upon the Moro patent for its disclosure of the detection of the size of an original document in a system that receives multiple documents of different sizes. See, for example, column 7, lines 49-55. The final Office Action acknowledges, however, that the Moro patent does not disclose the selection of paper with a size equal to or larger than the detected maximum size of the images. For this reason, it relies upon the Miyake patent.

At page 9, paragraph 17, the Office Action refers to the layout quantity assessment unit F3 described in the Miyake patent at column 3, lines 25-29, and column 4, lines 21-30, and states that this disclosure "reads on a selecting unit for selecting paper with a size equal to or larger than the detected maximum size." It is respectfully submitted that the disclosure of the Miyake patent does not support this statement. In particular, it does not disclose that the layout quantity assessment unit functions to select the *size* of the paper on which the image is to be printed.

The Miyake patent discloses a processing device which enables multiple document images to be printed on a designated number of pages, in accordance with input from a user. In essence, the user inputs a value P designating the desired number of pages. Based upon this value, and the total number N of images in a print job, the layout quantity assessment unit F3 calculates a quantity n of images per page. This calculated value is then modified, if necessary, to conform to a standard number of images per page. Figures 2A-2E illustrate examples of image patterns relating to such standard numbers. Thus, the layout quantity assessment unit F3 does not select the *size* of the paper on which the images are to be printed. Rather, the assessment unit selects one of the *patterns* illustrated in Figures 2A-2E,

in accordance with the number of images to be printed, relative to the number of pages on which they are to be printed.

In the system of the Miyake patent, the size of the paper is pre-selected by the user. Figure 3 illustrates the print setup screen. As can be seen, one of the selections available to the user is the size of the sheet of paper on which the printing is to occur. The selected sheet size is provided as one of the inputs to an operations data acquisition unit E1, as shown at the top of Figure 4.

Hence, the rejection of claim 6 is based upon a mischaracterization of the teachings of the Miyake patent. Neither the Moro patent nor the Miyake patent discloses a selecting unit for selecting paper with a size equal to or larger than the *detected* maximum size of document images to be printed. Rather, the paper is selected on the basis of user input. The record does not establish a *prima facie* case of obviousness for claim 6, and therefore is not in an appropriate posture for submission to the Board of Appeals.

Claims 7-11

Claims 7-11 are directed to another embodiment of the invention, in which the magnification of the document images is based upon the detected maximum size of the document images. Claim 7 recites an image forming apparatus having a detecting unit for detecting a maximum size of the document images, and a calculating unit for calculating a scaling factor that causes the detected maximum size to match the size of a print area. The claimed apparatus also includes a processing unit for scaling the sizes of the document images based upon the calculated scaling factor. Claims 10 and 11 recite analogous subject matter in the context of a method, and a computer program product.

The rejection of claims 7-11 also relies upon a combination of the Moro and Miyake patents. Again, the Moro patent is cited for its disclosure of the detection of the size of an original document. The final Office Action acknowledges that the Moro patent does not disclose the calculation of a scaling factor that causes the detected maximum size to match the size of a print area, nor a processing unit for scaling the sizes of the document images based on the calculated scaling factor. To this end, it refers to the Miyake patent at column 3, lines 21-28, and alleges that it would be

obvious to modify the main control section 61 of the Moro patent with the print data generator E5 of the Miyake patent.

It is respectfully submitted that it would not be obvious to modify the Moro patent in this manner, since to do so would destroy the principle of operation of that patent. More particularly, the Moro patent discloses a technique in which a reduction rate is first established by the user by means of a reduction rate setting section 39 on a control panel 37 (column 7, lines 6-8). The patent describes a specific example in which the A3 to A4 reduction mode is selected (column 9, lines 8-9). Then, as documents are automatically fed for copying, their sizes are detected, and a determination is made whether the size of the document is equal to or smaller than the A4 size (Figure 8, step S4). Referring to the example illustrated in Figure 11, if the document is larger than A4, the image of that document is reduced by the designated amount and printed, by itself, on the output sheet 101. However, if the original document is of size A4 or less, the reduced image of that document will occupy no more than one half of the output sheet. Therefore, if two such documents are received in succession, as depicted by documents B and C in Figure 11, their reduced images are combined on a single output sheet 102.

Thus, the system of the Moro patent operates on the basis that a reduction factor is first selected by the user, and the size of each original document is then detected to determine whether, based on this designated reduction rate, an image of a single document or images of two documents will fit on the output sheet. In other words, the designated reduction rate sets a threshold factor that determines whether more than one original image can be printed on an output sheet. In this arrangement, the reduction factor is *first* established, and the size of the original document is *then* measured to make this determination.

The modification proposed in the final Office Action would destroy this disclosed sequence of operations. If the proposed modification were made, the size of the document would first be detected, and the scaling factor would then be established, to produce an entirely different result. As set forth in MPEP §2143.01, a proposed modification cannot change the principle of operation of a reference. If it does, then the teachings of the references are not sufficient to support a *prima facie* case of obviousness.

Conclusion

In view of the foregoing, neither of the rejections of claim 6 nor claims 7-11 establishes a *prima facie* case of obviousness for presentation to the Board of Appeals. The rejection of claim 6 is based upon a mischaracterization of the disclosure of the Miyake patent. The rejection of claims 7-11 proposes a combination that destroys the principle of operation of the primary reference.

Accordingly, the rejections of record should be withdrawn, rather than be presented for consideration by the Board of Appeals.

Respectfully submitted,
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